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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,062	09/26/2003	Eric L. Toussant	1884-0002	9292

28078 7590 11/08/2004  
MAGINOT, MOORE & BECK  
BANK ONE CENTER/TOWER  
1111 MONUMENT CIRCLE  
INDIANAPOLIS, IN 46204

EXAMINER


MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/673,062	<b>Applicant(s)</b> TOUSSANT ET AL.	
	<b>Examiner</b> William L. Miller	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr et al. (US#D443971) in view of Stanley (US#2002/0157294).
3. Regarding claims 1 and 8, Carr discloses ornamentation for a mailbox door having a perimeter shape, the ornamentation comprising a graphic display on the door.
4. Carr fails to disclose the graphic display being provided on a front surface of a flexible sheet of material wherein the material has an affinity for the door so that the sheet can be removably attached to the door without adhesive or mechanical fasteners as claimed by the applicant. Stanley discloses a graphic display 25 being provided on a front surface of a flexible sheet of material 24 having an affinity for a door 17 or 23 so that the sheet can be removably attached to the door without adhesive or mechanical fasteners thereby facilitating changing the ornamentation of the door without marring its surface. Therefore, as taught by Stanley, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carr by utilizing a flexible sheet of material having the graphic display on the front surface thereof wherein the material has an affinity for the door so that the sheet can be removably attached to the door without adhesive or mechanical fasteners thereby facilitating changing the ornamentation of the door without marring its surface.

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5. Although Carr in view of Stanley fails to disclose the perimeter of the flexible sheet being configured to substantially conform to the perimeter shape of the door, it would have been an obvious design choice to utilize a flexible sheet having a perimeter configured to substantially conform to the perimeter shape of the door as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).
6. Regarding claims 2 and 10, Stanley teaches the flexible sheet is magnetic.
7. Regarding claims 3 and 9, Stanley teaches the flexible sheet includes a contact surface (rear surface) opposite the front surface wherein the material exhibits a magnetic affinity only on the contact surface (abstract, lines 1-7).
8. Regarding claim 7, Carr discloses the door includes a peripheral rib, as best shown in Figs. 6 and 8, which defines a recessed surface therewithin, and this recessed surface includes the graphic display thereon wherein according to the figures has a thickness less than the rib height. Further, the flexible sheet taught by Stanley is disclosed as 0.020 gauge and would also have a thickness less than the rib height shown in Figs. 6 and 8 of Carr.
9. Claims 1, 4, 5, 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Saetre (US#5102171).
10. Regarding claims 1 and 8, Carr discloses ornamentation for a mailbox door having a perimeter shape, the ornamentation comprising a graphic display on the door.
11. Carr fails to disclose the graphic display being provided on a front surface of a flexible sheet of material wherein the material has an affinity for the door so that the sheet can be

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removably attached to the door without adhesive or mechanical fasteners as claimed by the applicant. Saetre discloses a graphic display being provided on a front surface of a flexible sheet of material 120 having an affinity for a door 40 or 42 so that the sheet can be removably attached to the door without adhesive or mechanical fasteners thereby facilitating changing the ornamentation of the door without marring its surface. Therefore, as taught by Saetre, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carr by utilizing a flexible sheet of material having the graphic display on the front surface thereof wherein the material has an affinity for the door so that the sheet can be removably attached to the door without adhesive or mechanical fasteners thereby facilitating changing the ornamentation of the door without marring its surface.

12. Although Carr in view of Saetre fails to disclose the perimeter of the flexible sheet being configured to substantially conform to the perimeter shape of the door, it would have been an obvious design choice to utilize a flexible sheet having a perimeter configured to substantially conform to the perimeter shape of the door as a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

13. Regarding claims 4, 5, and 11, Saetre teaches the material exhibits an electrostatic or static cling affinity (abstract).

14. Regarding claim 7, Carr discloses the door includes a peripheral rib, as best shown in Figs. 6 and 8, which defines a recessed surface therewithin, and this recessed surface includes the graphic display thereon wherein according to the figures has a thickness less than the rib height.

Further, the flexible sheet taught by Saetre is shown and disclosed as a thin sheet and would also have a thickness less than the rib height shown in Figs. 6 and 8 of Carr.

***Allowable Subject Matter***

15. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. The applicant argues the following: 1) Stanley and Saetre teach away from the claimed invention as changing the shape of these appliques would destroy their function and purpose, and 2) there is no motivation to combine Carr with Stanley or Saetre.

17. In response to argument 1), Stanley and Saetre do not teach away from the claimed invention as each disclose ornamentation (sheets) capable of being applied to doors. Further, Stanley discloses in paragraph [0021] the sheet 24 may take the form of various “graphic representations”, i.e. the sheet does not prohibit a change in shape. Likewise, Saetre discloses the sheet 120 may consist of the entire sheet (Fig. 1) or may be a design cut about the periphery thereof (col. 3, lines 36-39), i.e. the sheet does not prohibit a change in shape.

18. In response to argument 2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is well within the knowledge

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generally available to one of ordinary skill in the art. Moreover, one would turn to Stanley and/or Saetre to perfect the Carr design as Stanley and Saetre each teach door ornamentation which would improve the Carr design by enabling the door ornamentation to be varied for aesthetic purposes without marring (damaging) the door surface.

***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

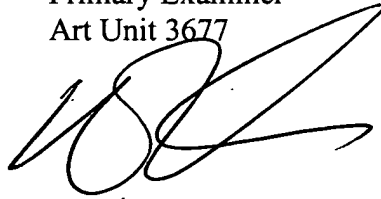
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Miller  
Primary Examiner  
Art Unit 3677

A handwritten signature in black ink, appearing to be 'WLM', with a large, stylized flourish extending from the end.

WLM  
11-03-2004